

REMARKS / DISCUSSION OF ISSUES

Claims 1-19 are pending in the application. Claims 9-19 are newly added.

The applicant thanks the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents, and for acknowledging that the drawings are acceptable.

Claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label numbers, and/or to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in intended scope and no new matter is added.

New dependent claims are added to at least partially restore the original range of claims that existed before multiple dependencies were removed in the preliminary amendment. No new matter is added.

The Office action rejects claims 1-8 under 35 U.S.C. 102(e) over Ficco et al. (USP 6,868,292, hereinafter Ficco). The applicant respectfully traverses this rejection.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Claim 1, upon which claims 2-4 and 7-8 depend, claims a method that includes retrieving first documents from a first set of application devices by a server; retrieving an identification of a user by the server; autonomously generating second documents by the server, each comprising at least one instruction, on the basis of at least a part of the retrieved identification of the user and at least a part of the first documents; sending at least one of the second documents to each device of a second set of the application devices by the server; and performing, for a given device of the second set, one instruction from at least one of the second documents received in the given device. Claim 5, upon which claim 6 depends, includes similar limitations.

Ficco fails to teach retrieving identification of a user by the server, and fails to teach generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents.

The Office action asserts that Ficco teaches retrieving an identification of a user by the server at column 16, lines 4-6. The applicant respectfully disagrees with this assertion. At the cited text, Ficco teaches:

"A spreading-code generator in the transmitter 910 generates a spreading code that identifies the designated device 915." (Ficco, column 16, lines 4-6.)

As is clearly evident, the cited text fails to address identification of a user, and specifically fails to teach retrieving an identification of a user by a server. Ficco's Figure 10 illustrates a lamp as the example designated device 915; obviously, a spreading code that identifies a lamp cannot reasonably be said to correspond to an identification of a user. Further, the transmitter 910 generates the spreading code that identifies the designated device 915, and does not 'retrieve' an identification, as specifically claimed in claims 1 and 5.

The Office action also asserts that Ficco teaches generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents. The Office action asserts that Ficco provides this teaching at column 16, lines 1-4. The applicant respectfully disagrees with this assertion. At the cited text, Ficco teaches:

"Transmitter 910 may also include a high-frequency oscillator that generates a carrier wave, and a high-frequency mixer that modulates the carrier with the baseband signal to generate a narrowband transmit signal." (Ficco, column 16, lines 1-4)

As is again clearly evident, the cited text fails to address identification of a user, and specifically fails to teach generating second documents on the basis of at least a part of a retrieved identification of the user, as specifically claimed in claims 1 and 5.

Because Ficco fails to teach each of the elements of each of the applicant's independent claims 1 and 5, and because the Office action fails to identify where Ficco provides the teachings of each of the elements of claims 1 and 5, the applicant respectfully maintains that the rejection of claims 1-8 under 35 U.S.C. 102(e) over Ficco is unfounded, per MPEP 2131, and should be withdrawn.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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